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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Fumiaki ARAI et al.

Serial No.: 10/060,458 Group Art Unit 1762
Filed : January 30, 2002 Examiner Jennifer Kolb Michener
For : THERMOSENSITIVE STENCIL PAPER AND METHOD
OF PRODUCING THE SAME

REPLY UNDER 37 C.F.R. § 1.111

1185 Ave. of the Americas
New York, N.Y. 10036
January 20, 2004

Commissioner for Patents,
P. O. Box 1450
Alexandria, VA 22313-1450

S I R:

In response to the Office Action dated October 23, 2003, applicants respectfully request reconsideration and further examination of the above-identified application for the reasons set forth below.

Claims 11-21 are in the application. Of these, claims 13, 15 and 21 have been withdrawn from consideration as a result of an election of species. Claims 11, 12, 14 and 16 through 20 have been rejected.

With reference to the rejection of claim 11 under 35 U.S.C. §102(e) as anticipated by Ohta et al., U.S. patent No. 5,843,560 (Ohta '560), it may initially be noted that the present invention according to claim 11 provides a method of producing a thermosensitive stencil paper comprising a thermoplastic resin film and a porous resin layer provided thereon, comprising the steps of coating on the thermoplastic resin film a porous resin layer formation coating liquid comprising a water-in-oil emulsion of a resin, and drying the coating liquid, thereby providing the porous resin layer on the thermoplastic resin film. The method of

producing a thermosensitive stencil paper of the present invention achieves stability of porous resin layer formation, high coating speed, and improved productivity (see the present specification, Table 4 on p. 42, and Table 5 on p. 48) by including a water-in-oil emulsion of a resin in the porous resin layer formation coating liquid.

Ohta '560 simply discloses a method of fabricating a heat-sensitive stencil which includes steps of applying a coating liquid containing the resin of the porous resin layer to the thermoplastic resin film, and drying the coating. Ohta '560 does not teach or suggest that the porous resin layer formation coating liquid contains a water-in-oil emulsion of a resin, and does not disclose or make obvious any technical effects obtainable by providing a water-in-oil emulsion of a resin in the porous resin layer formation coating liquid.

The Examiner asserts, in the outstanding Office Action (p. 3), that "the silicone oil and/or THF in the water solvent with an emulsifier," all of which are assertedly disclosed in Ohta '560, "will provide the water-in-oil emulsion required by Applicant" (refer to Ohta '560, TABLE 1 at col. 6, and the passage at col. 4, lines 16-20). Let it be assumed *arguendo* that, as the Examiner contends, it may be possible to produce an emulsion using the above compositions. In Ohta '560, however, silicone oil serves as a stick-preventing agent, THF serves as a good solvent, water serves as a bad solvent, and any emulsifier present is disclosed only as a surfactant. There is no description or evidence in Ohta '560 that the above compositions of the porous resin layer can be used for another purpose, such as producing an emulsion. Further, it is commonly known in the art that precise adjustments in an amount of each composition, adding method, and the like will be necessary to produce an emulsion and any adding method thereof. Therefore, the porous resin layer formation steps of the present

invention, utilizing liquid containing a water-in-oil emulsion of a resin, are not taught by and would not be obvious from the compositions disclosed in Ohta '560.

Accordingly, the invention defined in present claim 11 is novel and unobvious over Ohta '560. In particular, the recital of "a water-in-oil emulsion of a resin" distinguishes claim 11 patentably over Ohta '560.

Claims 12 - 21 likewise distinguish patentably over Ohta '560 by virtue of their dependence on claim 11. Since generic claim 11 is submitted to be allowable, consideration and allowance of withdrawn dependent species claims 13, 15 and 21 are respectfully solicited.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

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